

Remarks

Upon entry of the foregoing amendment, claims 1-84 are pending in the application, with claims 1, 66, 69, and 81 being the independent claims. Claims 66 and 82 are sought to be amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Claims 66 and 82 are amended to correct clerical errors. Support for the amendments to claims 66 and 82 is found throughout the specification and claims as originally filed.

Reply to Restriction Requirement and Election of Species

In reply to the Office Action dated **June 2, 2004**, requesting an election of one group of claims to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the claims of Group I, represented by claims 1, 4, 9-19, 21-45, and 48-58. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. Applicants reserve the right to pursue the nonelected claims in one or more divisional applications.¹

This election is made **with** traverse.

With respect to the Examiner's division of the claims into fifteen groups, and the reasons stated therefor, Applicants respectfully traverse. First, all of the claims can be examined without serious burden on the Examiner because a search of the art for the claims of group I should find art relevant to the claims of any other groups. Further, the claims of groups I-IV are grouped in the same class and subclass. Likewise, groups V and VI are grouped in the same class and subclass; Groups VII and XIII are grouped in the same class and subclass; Groups IX and XV are grouped in the same class and subclass; and Groups X-XII are grouped in the same class and subclass. Further, the claims of Groups I-VIII, XIII, and XIV are grouped into the same class for search purposes, and the claims of Groups IX-XII and XV are grouped into the same class for search purposes. Therefore, fewer restriction groups should expedite prosecution without an undue burden on the Examiner.

¹ Applicants note that claim 82 was not assigned to any group in the Restriction Requirement. Applicants believe that claim 82, as amended herein to correct a clerical error, would logically belong with claim 81, and thus would fall in Group XIV as categorized by the Examiner. If the Examiner should disagree, further clarification is respectfully requested.

At a minimum, the claims of Groups I-IV should be examined together because they can both be searched in the same class and subclass and are drawn to an interrelated method of selecting polynucleotides.

In the Office Action at pages 3-4, the Examiner asserted that "[t]he different methods of groups I-VII and X-XIII are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01)." Applicants respectfully disagree.

The Examiner cited M.P.E.P. sections 806.04 and 808.01 to support the Restriction Requirement. Applicants respectfully assert that the Examiner's reliance on these sections of the M.P.E.P. to support the restriction requirement is misplaced.

Section 808.01 of the M.P.E.P. states:

Where the inventions claimed are independent, i.e., where they are not connected in design, operation, or effect under the disclosure of the particular application under consideration (MPEP § 806.04), *the facts relied on for this conclusion are in essence the reasons for insisting upon restriction.* This situation, except for species, is but rarely presented, since persons will seldom file an application containing disclosures of independent things.

(Italics in original) (underline added). The first Examiner Note in M.P.E.P section 808.01 states that the form paragraph regarding unrelated inventions "is to be used *only* when claims are presented to unrelated inventions, e.g., a necktie and a locomotive bearing." *Id.* (emphasis added).

Section 806.04 of the M.P.E.P. sets forth examples of situations where two or more inventions are independent, and where restriction would be proper:

(A) Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

M.P.E.P. § 806.04.

Contrary to the Examiner's assertions on page 3 of the Office Action, the claims of Groups I-VII and X-XIII do not fit into this situation. Rather, the claims of Groups I-VII and X-XII are capable of use together, do not have different modes of operation, and do not have different functions or effects.

First, unlike the example of a process of painting a house and a process of boring a well, the claims of Groups I-VII and X-XIII clearly *are* capable of use together. The Examiner's own statements are evidence of the fact that Groups I-IV, for example, are capable of use together:

[i]n the instant case, the group I methods are drawn to a method of identifying polynucleotides encoding polypeptides of first library; *group II method uses the first library polynucleotides* to identify the polynucleotides of the first library (see step j); *group III uses the polynucleotides of the first library identified in the group II method* to identify polynucleotides of group III method; *group IV uses the polynucleotides of the second library identified in the group III method* to identify polynucleotides of group IV method.

Office Action at page 4 (emphasis added). If each group of claims can be characterized as using the polynucleotides identified by the method of another group then, necessarily, the methods are capable of use together.

Second, the claims of Groups I-VII and X-XIII clearly do not have separate modes of operation. Again, Groups I-IV serve as an example, as a comparison of claims

3 (in Group II) and 7 (in Group IV), shows that they recite similar steps to enrich the populations of polynucleotides of the first and second libraries, respectively. Thus, the methods do not have different modes of operation in the manner illustrated by the examples set forth in section 806.04 of the M.P.E.P.

Third, the claims of Groups I-VII and X-XIII clearly do not have different functions or effects. Groups I-IV, for example, are all directed to methods of selecting polynucleotides, which together encode a functional intracellular immunoglobulin. These claims are clearly not within the meaning of "different functions or effects," such as a shoe and a locomotive bearing claimed in the same application, as illustrated in section 806.04 of the M.P.E.P.

Even assuming, *arguendo*, that Groups I-XV represent distinct or independent inventions, Applicants submit that to search and examine the subject matter of these Groups together would not be a serious burden on the Examiner. In particular, any art related to a method of selecting from libraries of polynucleotides which encode an intracellular immunoglobulin molecule is very likely to overlap substantially with art related to an intracellular immunoglobulin and with art related to a kit for selecting intracellular immunoglobulins from libraries of polynucleotides. Accordingly, it would not be an undue burden for the Examiner to search, *at a minimum*, Groups I-IV and VII together.

The M.P.E.P. § 803 (Eighth Edition, Rev. Feb. 2003) states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, in view of the M.P.E.P. § 803, Applicants respectfully request that all claims be searched and examined in the subject application. Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Reconsideration and withdrawal of the Restriction Requirement, *in particular*, withdrawal of the Restriction Requirement as between Groups I-IV and VII, and consideration and allowance of all pending claims, are respectfully requested.

The Examiner has also required numerous species elections. Applicants' provisional elections are listed below, along with a listing of each of the claims believed to read on each of the provisionally-elected species.

These elections are made **with traverse**.

a) The Examiner has required an election of species among eukaryotic virus vectors. Applicants hereby provisionally elect to prosecute the species comprising a vaccinia virus vector for the first and/or second libraries. Out of the utmost caution in being fully responsive, Applicants further specify that the provisionally elected species comprising a vaccinia virus vector is not attenuated, and is not deficient in D4R synthesis. Claims 1-27 and 29-84 read on the provisionally elected species.

b) The Examiner has required an election of species among naturally-occurring genomes. Applicants hereby provisionally elect to prosecute the species comprising linear, double-stranded DNA for the first and/or second libraries. Claims 1-27 and 29-84 read on the provisionally elected species.

c) The Examiner has required an election of species among promoters.

Applicants hereby provisionally elect to prosecute the species comprising a T7 phage promoter for both the first and second libraries. Claims 1-41 and 44-84 read on the provisionally elected species.

d) The Examiner has required an election of species among modified phenotypes.

Applicants hereby provisionally elect to prosecute the species comprising cell differentiation. Claims 1-84 read on the provisionally elected species.

e) The Examiner has required an election of species among heterologous peptides. Applicants hereby provisionally elect to prosecute the species comprising an SV40 large T antigen nuclear localization sequence for the first and/or second libraries. Claims 1-84 read on the provisionally elected species.

Applicants respectfully traverse and request the withdrawal of the requirement for election of species. On page 5 of the Office Action, the Examiner asserts that the claims are directed to patentably distinct species. However, as a threshold matter, Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the subgroups listed by the Examiner represent patentably distinct species, restriction remains improper unless it can be shown that the search and examination of the listed groups would entail a "serious burden." *See*

M.P.E.P. § 803. In the present situation, no such showing has been made. For example, although the Examiner has asserted that embodiments referring to eukaryotic virus vectors are distinct species, Applicants submit that a search of vaccinia virus as a eukaryotic virus vector would provide useful information regarding other types of eukaryotic viruses, such as herpesviruses. Thus, the search and examination of all species would not entail a serious burden.

Applicants assert the right to have additional species examined in the event that a generic claim is found to be allowable in accordance with 37 C.F.R. § 1.141(a).

Reconsideration and withdrawal of the Requirement for Election of Species, and consideration and allowance of all pending claims, are respectfully requested.

Summary

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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